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| | | | KUCAB, JAMIE R | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/660,263

Applicant(s)

DOMINGUEZ ET AL.

Examiner

JAMIE KUCAB

Art Unit

3621

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 September 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50 and 52-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50 and 52-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/3/08
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. Applicant's response filed September 2, 2008 is acknowledged.
2. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-54 are pending in the application.
3. This Office action is given Paper No. 20081029 for reference purposes only.
4. Based on a comparison of the PGPub 2004/0059688 with Applicant's originally submitted specification, the PGPub appears to be a fair and accurate record of the Applicant's specification. Therefore, if necessary any references in this action to Applicant's specification refer to paragraph numbers in the PGPub.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 25-36 and 52-54 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. Under the broadest reasonable interpretation standard, the Examiner is interpreting the "trusted party" and "presenter" to include human beings. Therefore, claims 25-36 and 52-54 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. A claim directed to or including within its scope a human being or attributes of a human being is not patentable subject matter. See MPEP §2105 and 1077 OG 24 (April 21, 1987).

Claim Rejections - 35 USC § 112 1st Paragraph

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-54 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. The claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The limitations of a "trusted party computer" (and that various method steps are performed by this computer) and the notifying occurring in "real time" were not previously disclosed, nor could antecedent basis be found in the specification. A search of the specification found no instances of either term.

Claim Rejections - 35 USC § 112 2nd Paragraph

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-54 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Regarding claim 1, Applicant's recitations "A method ... during an on-line transaction" (preamble) and "receiving ... during an enrollment process" (lines 4-5) taken together would have been unclear to a person having ordinary skill in the art at the time of the invention. On one hand, the method appears to include the transaction process only. On the other hand, the method appears to also include an enrollment process ("receiving...", "verifying...", and "communicating") necessarily completed prior to the transaction process. For purposes of comparison with the prior art, the Examiner is interpreting the method to include both the enrollment process and the authentication process (contrary to what is implied by the preamble). Appropriate clarification - including, if possible, clarifying references to the specification - and/or correction is required. Claims 25, 37, and 52 are similarly confusing as to whether the method/system comprises both an authentication method/system or an enrollment and authentication method/system.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects

for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

13. Claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-54, as understood by the Examiner in light of the above 112 2nd paragraph rejection, are rejected under 35 U.S.C. §102(e) as being anticipated by Dominguez et al. (2004/0059688 A1, hereinafter, Dominguez).

14. Regarding claims 1-7, 9-18, 20, 21, 23-37, 39-41, 44-47, 49, 50, and 52-54, Dominguez discloses (at least in Figs. 1 and 8 and the associated text) the claimed invention including:

- a. receiving, by said trusted party via the trusted party computer during an enrollment process, profile data and enrollment data from said presenter, said trusted party being an issuer of an account to said presenter and said presenter having transmitted said profile data to said trusted party ([0042], [0065]);
- b. verifying, by said trusted party during said enrollment process using said enrollment data, the identity of said presenter and associating authentication data with said presenter ("The trusted party can use a web-enabled, interactive "identity authentication service" provided by an outside entity during the enrollment process to help validate an account holder's identity," [0042]);
- c. communicating said authentication data ("password" or "token") between said trusted party and said presenter during said enrollment process, said authentication data being known only to said trusted party and to said presenter ([0065]);

- d. receiving said submitted profile data ("cardholder's primary account number") at said trusted party computer from said acceptor (steps 2 and 3, Fig. 8);
- e. comparing said submitted profile data against said profile data stored by said trusted party ("comparing the Account Identifier supplied in the two messages," [0130]);
- f. receiving, at said trusted party computer, submitted authentication data from said presenter during said on-line transaction; authenticating, by said trusted party computer, said presenter by comparing said submitted authentication data received from said presenter with said authentication data; validating, by said trusted party, said submitted profile data using results of said comparing and results of said authenticating (step 8, Fig. 8; [0131]);
- g. notifying said acceptor by said trusted party that said submitted profile data of said presenter is either authentic or erroneous, during said on-line transaction and in real time whereby said trusted party validates said submitted profile data of said presenter for the benefit of said acceptor (steps 9 & 10, Fig. 8; [0132]).

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claims 1-7, 9-18, 20, 21, 25-37, 39-41, 44-47, 49, 50, and 52-54, as understood by the Examiner, are rejected under 35 U.S.C. §103(a) as being unpatentable over Carrott et al. (hereinafter Carrott, 6,839,692 B2), in view of Tsuei et al. (hereinafter Tsuei, US 2004/0083184 A1), and further in view of Sipman et al. (hereinafter Sipman, 6,889,325 B1).
17. As per claims 1-3, 6, 7, 37 and 41, Carrott discloses a method involving a presenter, a trusted party, and an acceptor for validating profile data of said presenter during an on-line transaction comprising: receiving said profile data at said trusted party via the trusted party computer (Col. 2, lines 5-10; Col. 3, lines 4-10; Col. 4, lines 8-18; Col. 5, lines 25-38 and 55-67; Col. 6, lines 60-65); receiving and comparing said profile data against reference data stored by said trusted party (Col. 2, lines 5-10 and 20-33; Col. 3, lines 4-10; Col. 7, lines 4-10 and 17-25); notifying said acceptor by said trusted party that said profile data of said presenter is either authentic or erroneous, whereby said trusted party validates said profile data of said presenter for the benefit of said acceptor (Col. 2, lines 5-10 and 20-33; Col. 7, lines 24-42).
18. Carrott does not explicitly disclose receiving by said trusted party an enrollment process (see background of the invention), profile data and enrollment data from said presenter and verifying the identity of said presenter, said trusted party being an issuer of an account to said presenter wherein authentication data is received and validated as per the customer profile during an online transaction.

19. Tsuei, however, teaches a dynamic and comprehensive system and method for processing and authentication of transactions via identified customer profiles without revealing any information the requesting party (see figure 2 and associated text, ¶¶14, 17, 19, 25, 66). According to Tsuei, once a subscriber enrolls and registers providing profile and enrollment data, a unique identifier is associated with that customer, upon matching such data and verification of the identity and credentials of the customer, notification is provided for the benefit of the requesting party over the Internet (summary of the invention, fig 2 and associated text, ¶¶14, 17, 19, 70-74, 89-114; also see 158-160, creation of vault database). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the invention to modify Carrott's purchase transaction system to provide an anonymous transaction verification mechanism to provide security to the subscriber while at the same time providing further verification confirmation for the requestor.

20. Furthermore, Carrott does not explicitly disclose communicating said authentication data between said trusted party and said presenter during said enrollment process, said authentication data being known only to said trusted party and to said presenter.

21. Tsuei teaches that HPS 118 uses a standard credit card authorization system. However, the issuer must establish a method for authenticating the cardholder of an alias account. In an embodiment of the invention, this is accomplished by using the alias "password" that was entered during account setup. The issuer should also have some special procedures to handle referrals and hot calls. Since none of the information on

the alias account is real, a phone number is set in the phone number field that will allow the issuer to communicate with the vault and request contact with the cardholder [0139]. Therefore, it would have been obvious to one of ordinary skill in the art to modify Carrott to include assigning a password during the enrollment process that is known to the user and sent to the trusted party to authenticate communication between the parties.

22. The combination of Carrott/Tsuei does not explicitly disclose validating, by said trusted party, said submitted profile data using *both* results of said comparing and results of said authenticating.

23. However, Sipman teaches validating, by said trusted party ("transaction server"), said submitted profile data using *both* results of said comparing ("The transaction server 20 processes the transactions, after thorough verification of the validity of the transactions, using the party's profiles, as stored in the transaction server 20,") and results of said authenticating ("password" or "digital signature," C6 L3-68).

24. Therefore, it would have been obvious to modify the system/method of Carrott/Tsuei to include the validation/comparison of Sipman in order to achieve the predictable result of providing reliable data to the acceptor.

25. The combination of Carrott/Tsuei does not explicitly disclose providing profile data from the trusted party to the acceptor.

26. However, Sipman teaches providing profile data from the trusted party to the acceptor ("Verified Form," Fig. 4 and associated text).

27. Therefore, it would have been obvious to modify the system/method of Carrott/Tsuei to include the provision of profile data of Sipman in order to achieve the predictable result of providing reliable data to the acceptor.

28. As per claims 4 and 5, Carrott further discloses wherein the presenter and the acceptor communicate with said trusted party over the Internet (Abstract; Figure 1; Col. 3, lines 45-55; Col. 8, lines 10-15).

29. As per claims 9, 10, 44, 45, Carrott fails to disclose as noted above, however, Tsuei teaches a system wherein the program identity is an account number of financial account wherein the trusted third party maintains said account (fig 12-17, 20 and associated text). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include a program identity number such as an account number, unique identifier or other code of some sort issued and stored by the trusted party so that the trusted party has a unique number or code associated with the presenter as taught by Tsuei et al and which may be used later to identify the presenter or an account maintained by the trusted party.

30. As per claims 11-12 and 14-17, Carrott et al further disclose initiating communications between the presenter and acceptor and receiving profile data and a program identity number at the acceptor for the presenter (Col. 4, lines 5-18; Col. 5, lines 25-38). Carrott et al, however, fail to explicitly disclose receiving identity data at the acceptor. Tsuei et al disclose a method for verifying the identity of on-line credit card purchasers and further teach receiving, at a trusted party, authenticating data from the presenter; comparing, by the trusted party, the authenticating data against pre-

designated authenticating data previously designated for the presenter and notifying the acceptor by the trusted party that the identity of the presenter is either authentic or erroneous, whereby the trusted party authenticates the identity of the presenter for the benefit of the acceptor (fig 2, 12-20 and associated text, ¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include authenticating the identity of the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card. Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

31. As per claim 13, Carrott et al further disclose querying the trusted party by the acceptor whether account data updating can be provided (Col. 2, lines 25-33).

32. As per claims 18 and 20-21, Carrott et al further disclose transmitting a data authentication request message from said acceptor to said trusted party in order to request that said trusted party validate said profile data of said presenter as discussed above. Carrott et al, however, fail to disclose requesting that the third party authenticate the identity of the presenter. Tsuei et al disclose a method for requesting that the trusted party verifying the identity of on-line credit card purchasers and further teach notifying the acceptor that the identity is authentic when the data matches (fig 2, 12-20 and associated text, ¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al

and include authenticating the identity of the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card.

Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

33. As per claims 25, 27, 52 and 54, Carrott et al disclose an on-line data authentication system comprising: a trusted party who receives, validates and provides profile data of a presenter (Figure 1; Col. 2, lines 5-10 and 20-33; Col. 3, lines 4-10; Col. 4, lines 8-18; Col. 5, lines 25-38 and 55-67; Col. 6, lines 60-65; Col. 7, lines 4-10 and 17-25); an acceptor who conducts a transaction with said presenter and who requests said trusted party to validate said profile data of said presenter (Figure 1; Col. 6, lines 60-67; Col. 7, lines 1-10); and a directory server configured to determine the existence of said trusted party who will be able to validate said profile data of said presenter (Col. 6, lines 60-67; Col. 7, lines 1-10).

34. Carrott et al further disclose local user authentication wherein the user inputs a user ID and password which is then verified by the users computer prior to proceeding (Col. 5, lines 57-63; Col. 6, lines 20-25). Carrott et al, however, fail to explicitly disclose receiving authentication data at a trusted party during an enrollment process, said trusted party being an issuer of an account to said presenter in which enrollment data is used to verify the identity of said presenter, and an acceptor requesting the trusted party to authenticate the identity of the presenter. Tsuei et al disclose a method for verifying

the identity of on-line credit card purchasers and further teach receiving during an enrollment process, at a trusted party, authenticating data from the presenter; comparing, by the trusted party, the authenticating data against pre-designated authenticating data previously designated for the presenter; and notifying the acceptor by the trusted party that the identity of the presenter is either authentic or erroneous, whereby the trusted party authenticates the identity of the presenter for the benefit of the acceptor (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include authenticating the identity of the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card. Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

35. Furthermore, Carrott does not explicitly disclose communicating said authentication data between said trusted party and said presenter during said enrollment process, said authentication data being known only to said trusted party and to said presenter.

36. Tsuei teaches that HPS 118 uses a standard credit card authorization system. However, the issuer must establish a method for authenticating the cardholder of an alias account. In an embodiment of the invention, this is accomplished by using the alias "password" that was entered during account setup. The issuer should also have some

special procedures to handle referrals and hot calls. Since none of the information on the alias account is real, a phone number is set in the phone number field that will allow the issuer to communicate with the vault and request contact with the cardholder [0139]. Therefore, it would have been obvious to one of ordinary skill in the art to modify Carrott to include assigning a password during the enrollment process that is known to the user and sent to the trusted party to authenticate communication between the parties.

37. As per claims 26 and 53, Carrott et al further disclose wherein the presenter and the acceptor communicate with said trusted party over the Internet (Abstract; Figure 1; Col. 3, lines 45-55; Col. 8, lines 10-15).

38. As per claim 28, Carrott et al fail to disclose as above, however, Tsuei et al disclose receiving and storing authenticating data from the presenter at the trusted party wherein the authenticating data becomes the pre-designated authenticating data (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include receiving and storing, at the trusted party, authenticating data of the purchaser as pre-designated authenticating data for purposes of authenticating the identity of the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card. Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

39. As per claims 29-30, Carrott et al fail to disclose, however, Tsuei et al disclose providing, by the trusted party, to the presenter a program identity number which is correlated with the identity, profile data and authenticating data and storing the program identity number by the trusted party (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include a program identity number such as an account number, unique identifier or other code of some sort issued and stored by the trusted party so that the trusted party has a unique number or code associated with the presenter as taught by Tsuei et al and which may be used later to identify the presenter or an account maintained by the trusted party.

40. As per claims 31-32, Carrott et al disclose a request message transmitted from the acceptor to the trusted party via a directory server, the message containing a query as to whether the trusted party will be able to validate the profile data of the presenter (Col. 6, lines 45-67) and a response message for validating the profile data of the presenter (Col. 2, lines 5-10 and 20-33; Col. 7, lines 24-42). Carrott et al, however, fail to disclose transmitting a message to the third party querying the third party as to whether the third party will be able to authenticate the identity of the presenter. Tsuei et al disclose a method for requesting that the trusted party verifying the identity of on-line credit card purchasers and further teach notifying the acceptor that the identity is authentic when the data matches (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include authenticating the identity of

the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card. Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

41. As per claims 33-36, Carrott et al disclose a request message transmitted from the acceptor to the trusted party via a directory server, the message requesting that the trusted party validate the profile data of the presenter, the request message including profile data of the presenter (Col. 2, lines 5-10; Col. 3, lines 4-10; Col. 4, lines 8-18; Col. 5, lines 25-38 and 55-67; Col. 6, lines 60-65) and a response message for validating the profile data of the presenter and whether or not the profile data is accurate or contains errors (Col. 2, lines 5-10 and 20-33; Col. 7, lines 24-42). Carrott et al, however, fail to disclose transmitting a message to the third party requesting that the third party authenticate the identity of the presenter. Tsuei et al disclose a method for requesting that the trusted party verifying the identity of on-line credit card purchasers and further teach notifying the acceptor that the identity is authentic when the data matches (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the method of Carrott et al and include authenticating the identity of the purchaser as taught by Tsuei et al so that the merchant is ensured that the purchaser is the authorized user for the credit card. Tsuei et al provides motivation by indicating that there is a need for a method or system for verifying the identity of an on-line purchaser, and ensuring to a

reasonable extent that the purchaser is in fact the party authorized to use the credit card presented for payment.

42. As per claims 39-40, Carrott et al further disclose wherein the presenter, acceptor and trusted party communicate over the Internet (Abstract; Figure 1; Col. 3, lines 45-55; Col. 8, lines 10-15).

43. As per claim 46, Carrott et al further disclose wherein the identity and profile data include at least the name and address of the presenter (Col. 2, lines 20-33; Col. 5 line 60-Col. 6 line 3; Col. 7, lines 24-34).

44. As per claims 47 and 50, Carrott et al further disclose transmitting a data authentication request message from said acceptor to said trusted party in order to request that said trusted party provide said profile data of said presenter (Figure 2; Col. 2, lines 20-33; Col. 5 line 60-Col. 6 line 3; Col. 7, lines 24-34); and transmitting a data authentication response message from said trusted party to said acceptor, said data authentication response message containing said profile data of said presenter (Col. 2, lines 20-33; Col. 5 line 60-Col. 6 line 3; Col. 7, lines 24-34).

45. As per claim 49, Carrott et al fail to disclose the features noted as per claim 37 above and asking the presenter, by the trusted party, for permission to provide the profile data of the presenter to the acceptor. However, Tsuei et al disclose requesting the presenter, by the trusted party, for the authenticating data (fig 2, 12-20 and associated text, ¶¶12-30, 70-158). Examiner takes Official Notice, however, that utilizing a third party entity to essentially filter customer personal or profile data provided to merchants based on permissions controlled by the customer is well known in the art and

it would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify the reference to Carrott et al and include the ability to filter the information provided to the merchant. One would have been motivated to filter this type of customer personal or profile data since it was well known at the time of applicant's invention that consumers were generally concerned about divulging personal or private information.

46. As per claims 23-24, Carrott et al further disclose (Col. 2, lines 25-33, see also updating disclosed in Tsuei).

47. Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Carrott/Tsuei/Sipman in view of Examiner's Official Notice.

48. Regarding claim 23, Carrott/Tsuei/Sipman discloses all the elements of the claimed invention, but Carrott/Tsuei/Sipman fails to explicitly disclose providing, by the trusted party, of updated profile data when the profile data is determined to be out of date.

49. However, the Examiner takes Official Notice that it is old and well known in the art to provide updated profile data in response to out of date profile data in order to provide the most accurate information available because to do otherwise would be inefficient, as it would likely require updated data at a later time and the inaccurate information could be further propagated to others.

50. It would have been obvious to a person having ordinary skill in the art at the time of the invention to modify the method of Carrott/Tsuei/Sipman to include the provision of updated profile information of Examiner's Official Notice in order to decrease the

possibility of providing inaccurate data that might require greater time and effort to resolve later in the transaction process.

Examiner Note

51. The Examiner has cited particular columns, line, and/or paragraph numbers in the references as applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the Applicant, in preparing responses, to fully consider a reference in its entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

Claim Interpretation

52. Independent claims (1, 25, 37, and 52) are examined together. If Applicant expressly states on the record that two or more independent and distinct inventions are claimed in this application, the Examiner may require the applicant to elect an invention to which the claims will be restricted.

53. The USPTO interprets claim limitations that contain statements such as "*if, may, might, can, could, when, potentially, possibly*", as optional language (this list of examples is not intended to be exhaustive). As matter of linguistic precision, **optional claim elements do not narrow claim limitations**, since they can always be omitted (*In*

re Johnston, 77 USPQ2d 1788 (Fed. Circ. 2006)). They will be given less patentable weight, because language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.

Response to Arguments

54. Applicant's arguments with respect to the 103 rejections of the claims have been considered but are moot in view of the new grounds of rejection.

55. Applicant's arguments with respect to the 101 rejections of claims 1, 37, and their dependents have been fully considered but they are persuasive. The 101 rejections of claims 1, 37, and their dependents have been withdrawn.

Conclusion

56. References considered pertinent to Applicant's disclosure are listed on form PTO-892. All references listed on form PTO-892 are cited in their entirety.

57. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Jamie Kucab whose telephone number is 571-270-3025. The Examiner can normally be reached on Monday-Friday 9:30am-6:00pm EST.

58. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached on 571-272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

59. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JK

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